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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,278	11/22/2000	Michelle Q. Wang Baldonado	A0834	2069
47374	7590	05/12/2006		
LAW OFFICES OF PARTICK J.S. INOUE 810 THIRD AVENUE SUITE 258 SEATTLE, WA 98104				
EXAMINER LESNIEWSKI, VICTOR D				
ART UNIT		PAPER NUMBER		
2152				

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/717,278	WANG BALDONADO ET AL.	
	Examiner	Art Unit	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 2/27/2006 has been placed of record in the file.
2. Claims 1, 7, 13, 19, 20, 22, and 23 have been amended.
3. Claims 9 and 15 have been canceled.
4. Claims 24 and 25 have been added.
5. Claims 1-8, 10-14, and 16-25 are now pending.
6. The applicant's arguments with respect to claims 1-8, 10-14, and 16-25 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Response to Amendment

7. Claims have been amended to show determining and updating the digest based on the rules. The amendment proves a change in scope to the independent claims as the independent claims now explicitly state determining and updating the digest based on one or more of the sender-independent message-based rules that specify characteristics of the digest. However, none of the amended claims show a patentable distinction over the prior art of record as presented below.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10-14, and 16-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Richard Simoni Junior and Douglas Pan (UK Patent Application Number GB 2 324 627 A), hereinafter referred to as Pan.

10. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method, an information storage media, or an alternative system are rejected under the same rationale applied to the described claim.

11. Pan has disclosed:

- <Claims 1, 7, 13, and 19>

An electronic message management system comprising: a digest specification device that allows a user to obtain a plurality of digests from an information stream comprising a plurality of candidate messages by allowing the user to specify a set of one or more sender-independent message-based rules for each digest, wherein each set of one or more sender-independent message-based rules specifies one or more characteristics of the candidate messages; an information selection device that monitors the information stream and selects one or more of the plurality of candidate messages in the information stream that satisfy all of the rules in at least one of the sets of sender-independent message-based rules for at least one of the plurality of digests; and an electronic message management device that determines, for each of the selected candidate messages, which of the plurality of digests corresponds to the set of sender-independent message-based rules satisfied by the particular selected candidate message, that integrates each of the selected candidate messages into their respective corresponding digests, and that determines and updates the digest based on one or more of the sender-independent message-based rules

that specify characteristics of the digest (page 33, line 1 through page 34, line 9 and page 1, line 13 through page 2, line 9).

- <Claims 2, 8, and 14>

The system of claim 1, further comprising a digest management device that delivers the digest to a predetermined destination upon satisfaction of at least one of the one or more sender-independent message-based rules (figure 7 and page 33, lines 15-20).

- <Claims 3, 10, and 16>

The system of claim 1, further comprising an information sampling device that delivers the selected candidate messages to a predetermined destination based on one or more of the sender-independent message-based rules (figure 7 and page 33, lines 15-20).

- <Claims 4, 24, and 25>

The system of claim 1, further comprising a rule management device that manages the one or more sender-independent message-based rules (page 33, line 21 through page 34, line 2 and page 16, line 12 through page 17, line 6).

- <Claims 5, 11, and 17>

The system of claim 1, wherein the one or more sender-independent message-based rules include a Boolean comparison, a statistical-based selection criteria, a fuzzy logic based selection criteria, a keyword based selection criteria, a date, a subject, a recipient, or a sender-based selection criteria (figure 13 and page 33, lines 9-12).

- <Claims 6, 12, and 18>

The system of claim 1, wherein the electronic message is at least one of an email, an electronic message from a mailing list, and a bulletin board posting (page 33, lines 9-14).

- <Claims 21, 22, 23, and 20>

The electronic message management system of claim 1, wherein the electronic message management device selects one or more of the candidate messages which meet one or more supplemental selection criteria (figure 13 and page 33, lines 9-12).

Since all the limitations of the invention as set forth in claims 1-8, 10-14, and 16-25 were disclosed by Pan, claims 1-8, 10-14, and 16-25 are rejected.

Response to Arguments

12. In the remarks, the applicant has argued:

- <Argument 1>

Pan does not disclose the features of claim 1 because he does not disclose a device “that determines and updates the digest based on one or more of the sender-independent message-based rules that specify characteristics of the digest” as recited in claim 1.

13. In response to argument 1, Pan does disclose determining and updating a digest as recited in claim 1. The line citation, page 33, line 1 through page, 34, line 9 and page 1, line 13 through page 2, line 9, clearly shows a system for determining and updating a digest based on filter criteria that specify characteristics of the digest. Pan’s system creates a custom newsgroup based on filter criteria.

14. In support of argument 1, the applicant has stated that the claim is distinguished over the prior art because “the characteristics of the individual digest, such as a threshold number of received messages, a predetermined inbox size, a predetermined user activity level, are automatically applied.” However, this is not a limitation of the claims. The applicant is

reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

15. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

16. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.


The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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SUPERVISORY PATENT EXAMINER